

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ADVANCED CARDIOVASCULAR)	
SYSTEMS, INC., and GUIDANT)	
SALES CORPORATION,)	
)	C.A. No. 98-80-SLR
Plaintiffs,)	(Consolidated with
)	C.A. No. 98-314-SLR
v.)	C.A. No. 98-316-SLR)
)	
MEDTRONIC VASCULAR, INC., and)	
MEDTRONIC USA, INC.,)	
)	
Defendants.)	

**MEDTRONIC'S TRIAL MEMORANDUM TO PREVENT
ACS FROM RELYING ON THE ATTORNEY-CLIENT
PRIVILEGE AS BOTH A SWORD AND A SHIELD**

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June 7, 2005

INTRODUCTION

During discovery in this case, ACS asserted the attorney client privilege to block inquiry into the views and opinions of its attorneys on the patentability of the claims of the Lau patents and to communications with ACS employees concerning those views and opinions. Because Medtronic was precluded from getting full discovery into communications between ACS and its attorneys, ACS's representatives (such as Mr. Lau or Mr. Orth) should not now be permitted to testify to knowledge, opinions, impressions or thoughts based in whole or in part on those communications. To the extent such testimony is permitted, however, ACS should be required to produce its privileged communications so that ACS does not assert the privilege as both a sword and a shield.

ARGUMENT

I. BECAUSE ACS CONSISTENTLY ASSERTED THE ATTORNEY-CLIENT PRIVILEGE TO BLOCK DISCOVERY INTO COMMUNICATIONS WITH COUNSEL CONCERNING THE PATENTABILITY OF THE LAU INVENTION, ACS'S REPRESENTATIVES SHOULD NOT NOW BE PERMITTED TO TESTIFY SELECTIVELY TO KNOWLEDGE, OPINIONS, IMPRESSIONS OR THOUGHTS BASED ON SUCH COMMUNICATIONS.

A. During Discovery, ACS Invoked The Attorney-Client Privilege To Block Discovery Into Communications With Counsel Concerning The Patentability Of The Lau Inventions.

During the deposition of its patent counsel, Edward Lynch, and others, ACS asserted the attorney-client privilege to prevent witnesses from testifying about counsel's thoughts and impressions concerning the patentability of the Lau patent claims.

For example, ACS invoked the attorney-client privilege to prevent Medtronic from questioning Mr. Lynch concerning his analysis of the Boneau prior art. ACS also blocked Medtronic from discovering the thoughts and impressions Lynch shared with people at ACS. For example, he was instructed not to testify regarding his analysis of the Boneau patent application and not to divulge details of his communications with ACS employees about that analysis. Lynch also purported to testify about his customs and practices (*see* excerpts of Lynch deposition, Ex. A at 38:7-22, 39:18-22, 139:4-9 and 146:13-21). Yet Medtronic could not get any specifics as to whether those so-called customs and practices were followed here because ACS has asserted the privilege as to a report Lynch prepared about the Boneau patent application (*see* Ex. B at 24:12-25:02, 25:20-26:03, 54:21-55:11, 91:1-13, 168:22-169:5, 171:16-172:14).

Other ACS witnesses were similarly cautioned or instructed not to divulge attorney-client communications concerning prior art analyses. These included ACS in-house counsel, Bruce Barclay, ACS co-inventors William Hartigan and Lilip Lau, ACS engineers Farhad Khosravi, and ACS executives Tim Kitchen and Gary Schneiderman.

B. Testimony Regarding Knowledge, Opinions, Impressions Or Thoughts Based In Whole Or In Part On Communications With Counsel Fall Within The Scope Of Subject Matter As To Which Privilege Was Asserted And Should Be Precluded.

With respect to any particular subject matter, privilege is an all-or-nothing proposition. If a litigant waives the privilege during discovery as to a particular communication, courts typically hold that the privilege has been waived as to all communications with counsel regarding the same subject matter. *See, e.g., In re Sealed Case*, 877 F.2d 976 (D.C. Cir. 1989) (waiver by subsequent disclosure of one document

waives privilege as to all communications on same subject matter); *In re Martin Marietta Corp.*, 856 F.2d 619 (4th Cir. 1988), *cert. denied*, 490 U.S. 1011 (1989) (implied subject-matter waiver as a result of statements by corporation to government in negotiating settlement); *Smith v. Alyeska Pipeline Serv. Co.*, 538 F. Supp. 977, 979 (D. Del. 1982) (finding that by disclosing some privileged communications, client waived privilege as to “the remainder of the communication [sic] which relate to the same subject matter”). Indeed, this Court previously required Guidant to produce its privileged documents in another proceeding because it was using the attorney-client privilege as both a sword and a shield. *Medtronic Inc. v. Guidant Corp.*, 2004 U.S. Dist. LEXIS 23468 (D. Del. 2004).

It is now too late for ACS to waive the privilege. Instead, the Court should require ACS to live within the bounds of the discovery that it has provided. In this case, that means not only that ACS cannot waive the privilege selectively by allowing its attorneys to testify to matters for which it previously claimed privilege. It also means that ACS should not be allowed to use the testimony of non-lawyers to selectively publish information based on attorney-client communications while invoking the privilege to block access to the complete communication. This exclusion relating to all testimony that could reveal even a portion of the attorneys’ thoughts or advice follows from the rationale behind the rule requiring consistency with respect to assertion of the privilege:

The attorney client privilege should not be used as both a sword and a shield. *See United States v. Rylander*, 460 U.S. 752, 758 (1983). The rationale behind this rule is one of fairness. As courts in this district have explained, it is unfair to allow a party to “disclose only those facts beneficial to its case and refuse to disclose, on the grounds of privilege, related facts adverse to its position” *Hercules, Inc. v. Exxon Corp.*, 434 F. Supp. 136, 156 (D.

Del. 1977).

Tracinda Corp. v. DaimlerChrysler AG, 362 F. Supp. 2d 487, 513 (D. Del. 2005).

Having now asserted that counsel's impressions and communications on the subject of the Boneau prior art and the Boneau patent application are privileged, ACS should not be allowed to elicit testimony based on those communications from others, but should instead be required to maintain the privilege at trial that it so consistently asserted during discovery.

There can be no question that this court may properly exclude evidence relating to the subject matter as to which ACS previously invoked the attorney-client privilege. For example, Judge Sleet recently excluded evidence that an attorney had been involved at all in a pre-filing investigation because privilege had been invoked during discovery as to the substance of the attorney's opinion. In *Software AG v. BEA Systems*, the Court held:

. . . . BEA would like to introduce evidence that its pre-litigation correspondence with SAG was handled in part by a patent attorney, while simultaneously asserting privilege as to his private communications with BEA, in an effort to show a lack of intent. In its brief, BEA denies that it will adduce evidence of any opinion that Meyer might have formed, or whether Meyer was asked to form such an opinion (D.I. 188 at 2). And yet, almost in the very next breath, BEA asserts that Meyer's significant participation in the pre-litigation correspondence with SAG is "highly probative" on the issue of willful infringement (*id.* at 3). This is an untenable position because Meyer's involvement can only be highly probative if it somehow reflects BEA's intent. But as discussed above, Meyer's involvement is legally irrelevant to BEA's intent. Therefore, the true value to BEA of this evidence is that it will permit BEA to give the jury a subtle "wink wink," in the hope that the jury will draw the improper inference that the patent attorney's involvement demonstrates BEA's lack of intent. Given the obvious prejudice to SAG, the court will not permit BEA to introduce the fact that Meyer was involved in the pre-

litigation correspondence with SAG, to the extent he is identified as a patent attorney.

Software AG v. BEA Sys., 2005 U.S. Dist. LEXIS 6021, *6-7 (D. Del. 2005).

This is consistent with this Court's stated view that litigants cannot take affirmative steps to restrict the scope of discovery by invoking the attorney-client privilege, but then seek to get evidence in beyond those restrictions. In *Arthrocare Corporation v. Smith & Nephew, Inc.*, 310 F. Supp. 2d 638 (D. Del. 2004), for example, the Court excluded testimony of a witness because he did not discuss the substance of that testimony in his deposition (which had take place approximately one week before the start of trial) because Smith & Nephew's counsel instructed him not to divulge the subject of his expected testimony citing attorney-client privilege and the work product doctrine. *Id.* at 668. Similarly, in the *Lucent Technologies* trial, Judge Farnan precluded Newbridge Networks from offering evidence relating to the same subject matter as to which it had invoked the privilege during discovery. The Court later upheld that ruling and denied Newbridge the new trial it sought based upon the supposed error of excluded the proffered evidence. *Lucent Techs., Inc. v. Newbridge Networks Corp.*, 168 F. Supp. 2d 181, 262 (D. Del., 2001) (Farnan, J.) ("In light of Newbridge's claims of attorney-client privilege which limited Lucent's discovery on Newbridge's investigation into the patents, and Newbridge's subsequent voluntary redaction of these documents to overcome Lucent's objection, the Court cannot conclude that Newbridge was unduly prejudiced by the exclusion of this evidence such that a new trial is warranted.").

If, however, such testimony is permitted, ACS should be required to produce its privileged documents so as to preclude ACS from relying on the privilege as both a sword and a shield.

CONCLUSION

For the foregoing reasons, Medtronic asks that the Court restrict ACS's factual presentation at trial to matters consistent with its decision to invoke attorney client privilege during discovery. In particular, Medtronic asks that the Court preclude ACS from seeking to elicit testimony as to knowledge, opinions, impressions or thoughts based to any degree whatsoever on communications with attorneys whose impressions and work have been shielded by assertion of the attorney-client privilege. In the alternative, the Court should deem the privilege waived and order ACS to produce its privileged documents.

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June 7, 2005

EXHIBIT A

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10 A. Prior art? Is this what you're
11 referring to?

12 Q. Yes, sir.

13 A. Okay. The duty to disclose prior art
14 is -- if the prior art references a material
15 reference, then you have an obligation. And if
16 it's truly a prior-art reference, then you have an
17 obligation to submit that to the Patent Office for
18 consideration.

19 Q. And, sir, during that same time
20 period, 1989 to 1991, what was your understanding
21 in terms of the standard of assessing materiality?

22 A. I'm not sure exactly what the
00037:01 specific criteria was. But generally speaking, if
02 you believe that the reference would be of
03 interest to the examiner in considering the
04 application, generally you submitted it.

10. PAGE 38:07 TO 38:22 (RUNNING 00:00:43.392)

07 Q. Back in the 1989 to 1991 time frame,
08 what was your practice to make sure that you
09 satisfied the duty of disclosure?

10 A. I'm not sure what you mean by "your
11 practice." But generally speaking, you know, if I
12 was aware of the reference, if I felt that it was
13 a material reference to the application that I was
14 involved with, I would submit it to the Patent
15 Office.

16 Q. Would you tell your clients about the
17 duty of disclosure?

18 A. Yes.

19 Q. Would you tell your client that they
20 had a duty to disclose all material prior art to
21 the Patent Office?

22 A. Yes.

11. PAGE 39:18 TO 39:22 (RUNNING 00:00:13.000)

18 Q. Sir, back during the 1989 to 1991
19 time frame, was it your practice to perform
20 prior-art searches in connection with the
21 applications that you were prosecuting?

22 A. Not usually.

12. PAGE 40:15 TO 41:04 (RUNNING 00:00:31.436)

15 Q. Sure. You had told us what your
16 understanding of the duty of disclosure was back
17 in the 1989 to 1991 time period. I'm asking you
18 now, in 1992 and the years following, what was
19 your understanding of the duty of disclosure?

20 A. I think it's basically the same.

21 Q. And was your understanding in 1992
22 and the years following regarding the standard for
00041:01 materiality -- was that also basically the same as
02 what you'd already told us?

03 A. Fundamentally it was as far as what I
04 considered to be material.

13. PAGE 41:05 TO 41:22 (RUNNING 00:01:00.200)

05 Q. Sir, has it ever been your custom and
06 practice to disclose prior-art references that you
07 believed were not material?

08 A. Yes.

09 Q. And when was that?

10 A. If I received a search report on a

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03 permission to disclose the E.S.S. application to
04 the Patent Office in connection with any of the
05 patent prosecution work you were doing for ACS?
06 A. I had no -- I had no recollection of
07 contacting Mr. Eakin for anything.

82. PAGE 130:03 TO 130:07 (RUNNING 00:00:12.000)

03 Q. Do you recall ever contacting anyone
04 outside of Mr. Eakin and asking for permission to
05 disclose the E.S.S. application to the Patent
06 Office?
07 A. No.

83. PAGE 131:03 TO 131:07 (RUNNING 00:00:25.700)

03 MR. O'NEILL: We have marked as
04 Exhibit 13-B a copy of the file history for
05 Application 07/783, 558 which bears Bates labels
06 ACS 231211 through to ACS 231334. It's a
07 double-sided copy.

84. PAGE 132:06 TO 132:09 (RUNNING 00:00:08.200)

06 Q. Sir, the application portion of 13-B,
07 is this what we've been referring to as the Lau
08 application?
09 A. It's my understanding that's correct.

85. PAGE 132:10 TO 132:16 (RUNNING 00:00:14.500)

10 Q. And this is the application where
11 you -- you reviewed the application -- I'm sorry.
12 Let me start over.
13 I think you had told us earlier that
14 you had one of your associates prepare the
15 application; is that correct?
16 A. They drafted the application.

86. PAGE 132:22 TO 133:03 (RUNNING 00:00:06.300)

22 Q. And you reviewed the application?
00133:01 A. Yes, I did.
02 Q. You approved it for filing?
03 A. I revised it.

87. PAGE 134:08 TO 134:10 (RUNNING 00:00:05.000)

08 Q. Sir, if you look down at the bottom
09 of that page, is that your signature?
10 A. I believe so, yes.

88. PAGE 134:11 TO 134:22 (RUNNING 00:00:43.400)

11 Q. Sir, do you recall when your
12 involvement in the prosecution of the Lau
13 application came to an end?
14 A. I don't have a recollection of when
15 that occurred. I remember it occurring, but I'm
16 not sure what time frame. My -- it appears that,
17 based upon the fact that the -- that the
18 Information Disclosure Statement was submitted by
19 the Fulwider people, it would appear that the file
20 had been transferred sometime between the filing
21 date and the date that the IDS was filed by the
22 Fulwider people.

89. PAGE 139:04 TO 139:09 (RUNNING 00:00:21.400)

04 Q. Sir, in drafting the Lau application,
05 do you remember whether you used any part of the

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06 E.S.S. application that Mr. Eakin had sent you?
07 A. I have no recollection of preparing
08 that application, but -- it's not likely, but I
09 have no specific recollection of that.

90. PAGE 139:22 TO 140:06 (RUNNING 00:00:15.200)

22 Q. Do you remember having a meeting with
00140:01 Mr. Lau and the other named inventors or anyone
02 else at ACS in terms of helping you to at least
03 give Mr. Thompson some guidance in putting this
04 application together?
05 A. I don't recall meeting Mr. Lau with
06 respect to his application.

91. PAGE 140:07 TO 140:13 (RUNNING 00:00:15.800)

07 Q. Do you recall meeting with anyone at
08 ACS -- them giving you information that assisted
09 in putting this application together?
10 A. No. I don't have any recollection of
11 meeting -- of either receiving the instructions or
12 talking with ACS personnel with respect to this
13 application.

92. PAGE 140:14 TO 140:19 (RUNNING 00:00:14.000)

14 Q. So if I'm understanding you, sir, am
15 I correct in saying that you don't have any
16 recollection of receiving any written or oral
17 instructions from anyone at ACS regarding this Lau
18 application?
19 A. That's correct.

93. PAGE 140:20 TO 141:07 (RUNNING 00:00:26.000)

20 Q. Sir, do you have any recollection of
21 the people -- withdraw the question.
22 Do you have any recollection of
00141:01 speaking with Ms. McDermott about anything that
02 pertained to the Lau application?
03 A. No.
04 Q. Do you have any recollection of
05 talking with Will Samson about anything that
06 pertained to the Lau application?
07 A. No.

94. PAGE 141:16 TO 141:19 (RUNNING 00:00:08.000)

16 Q. Do you recall having any contacts
17 with Mr. Simpson regarding anything having to do
18 with the Lau application?
19 A. Don't recall that.

95. PAGE 142:10 TO 142:15 (RUNNING 00:00:13.200)

10 Q. And do you recall speaking -- well, I
11 know what your answer's going to be, sir, but just
12 so the record is clear, do you have any
13 recollection of speaking with Mr. Orth regarding
14 anything having to do with the Lau application?
15 A. No.

96. PAGE 143:03 TO 143:18 (RUNNING 00:00:23.200)

03 You have no recollection of meeting
04 with Mr. Lau to discuss his inventions?
05 A. I don't have a recollection of that,
06 no.
07 Q. Do you have any recollection of

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08 meeting with Mr. Hartigan to discuss the
09 inventions?
10 A. No, I don't.
11 Q. Do you recall ever meeting
12 Mr. Hartigan?
13 A. I may have, but I don't have any
14 recollection of it.
15 Q. Do you have any recollection of ever
16 speaking with Mr. Hartigan?
17 A. I have no specific recollection of
18 that, no.

97. PAGE 144:12 TO 144:16 (RUNNING 00:00:10.000)

12 Q. But do you have any recollection of
13 speaking with Mr. Lau at any time in the 1989 to
14 1990 time period?
15 A. I don't have a recollection of that,
16 no.

98. PAGE 144:21 TO 145:03 (RUNNING 00:00:09.200)

21 Q. Do you have any recollection of ever
22 speaking with Mr. Frantzen regarding the
00145:01 inventions that are disclosed in the Lau
02 application?
03 A. No, I don't.

99. PAGE 145:06 TO 145:20 (RUNNING 00:00:35.500)

06 Do you have any recollection of ever
07 discussing -- having any discussions with Mr. Lau
08 regarding the prior art or what he believed was
09 the prior art with respect to the Lau application?
10 A. As I mentioned before, you know, I
11 have no recollection of meeting with or having
12 discussions with Mr. Lau about anything.
13 Q. Do you have any recollections of
14 speaking with or meeting with anyone at ACS
15 regarding the prior art to the Lau application?
16 A. I may have, but I have no
17 recollection of that.
18 Q. You have no general recollection at
19 all?
20 A. No.

100. PAGE 146:03 TO 146:12 (RUNNING 00:00:26.900)

03 Q. Do you remember having any
04 discussions with the named inventors or anyone at
05 ACS with respect to the duty of disclosure?
06 A. With respect to the Lau application?
07 Q. Yes, sir.
08 A. I don't have any recollection of
09 speaking with anyone at ACS with respect to the
10 Lau application. And I'm sure that would include
11 prior art about the Lau application. Now that's,
12 you know -- well, that's correct.

101. PAGE 146:13 TO 146:21 (RUNNING 00:00:22.900)

13 Q. Sir, do you recall any steps that you
14 took to ensure that the inventors complied with
15 the duty to disclose?
16 A. With respect to what now?
17 Q. The Lau application.
18 A. The Lau application? I don't recall
19 taking any specific steps. However, it would be
20 my practice to make sure the inventors knew that

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21 they had an obligation to disclose.

102. PAGE 147:17 TO 147:21 (RUNNING 00:00:11.200)

17 Q. So if I understand you, sir, it was
18 your position that when the file got transferred
19 back to the Fulwider firm you really had no more
20 involvement in it?

21 A. That's correct. Yeah.

103. PAGE 149:17 TO 149:19 (RUNNING 00:00:08.100)

17 Sir, did you submit prior art to the
18 Patent Office with respect to the Lau application?
19 A. I don't believe so, no.

104. PAGE 149:20 TO 150:08 (RUNNING 00:00:42.300)

20 Q. Do you recall whether there was a
21 reason for that?

22 A. The application was filed in -- I
00150:01 think in October, if that's correct, and it's my
02 understanding that at the time my normal practice
03 would be to file the IDS after the application was
04 filed. And usually I think you had until the
05 first office action to file the prior art before
06 it was considered by the office. And I
07 transferred the file to Fulwider before that date
08 occurred.

105. PAGE 154:21 TO 155:03 (RUNNING 00:00:14.100)

21 Q. Did anybody tell you while you were
22 working on the Lau application that Mr. Lau had
00155:01 actually conducted a study of some of the
02 prior-art stents?
03 A. I don't have a recollection of that.

106. PAGE 155:08 TO 155:13 (RUNNING 00:00:16.400)

08 Q. Sir, at any time did you or anyone
09 working under you prepare a -- perform a prior-art
10 search in connection with the Lau application?
11 A. I don't recall doing a prior-art
12 search nor someone under me doing a prior-art
13 search.

107. PAGE 160:20 TO 161:04 (RUNNING 00:00:24.200)

20 Q. Sir, I want to ask you a couple more
21 questions about the E.S.S. application. Do you
22 recall putting a copy of Mr. Eakin's March 9,
00161:01 1990, letter attaching the E.S.S. application into
02 the file that related to the Lau prosecution?
03 A. I don't have a recollection of doing
04 that.

108. PAGE 161:15 TO 161:22 (RUNNING 00:00:22.500)

15 Q. Sir, after you went to the Crosby
16 firm, and the Lau application, the prosecution
17 work, got sent back to the Fulwider firm, did you
18 think -- did you make copies of all your files and
19 send them back to the Fulwider firm?
20 A. No, I sent the actual files.
21 Q. Did you maintain copies for yourself?
22 A. No, I did not.

EXHIBIT B

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 Lynch, Edward (Vol. 01) - 05/20/2005

1 CLIP (RUNNING 00:39:43.718)

 Lynch Clips

LYN02

129 SEGMENTS (RUNNING 00:39:43.718)



1. PAGE 7:18 TO 8:08 (RUNNING 00:00:18.700)

18 Q. Sir, could you state your full name
19 for the record.
20 A. Edward Joseph Lynch.
21 Q. Mr. Lynch, good morning. You're an
22 attorney, correct?
00008:01 A. Yes. Correct.
02 Q. Sir, when did you become licensed to
03 practice law?
04 A. 1968.
05 Q. And, sir, you've been registered to
06 practice before the Patent Office since 1967,
07 correct?
08 A. That's correct.

2. PAGE 24:12 TO 25:02 (RUNNING 00:00:24.000)

12 Q. Mr. Lynch, I want to get back to some
13 of the documents that we were talking about that
14 you reviewed in preparation for today's
15 deposition.
16 I want to talk to you about the
17 report. I think you said that there was a 1990
18 report that you had prepared. Do you remember who
19 you had sent that report to?
20 A. I believe it was Bruce Barclay.
21 Q. And do you remember the subject
22 matter of that report?
00025:01 A. I believe it was the E.S.S.
02 application.

3. PAGE 25:20 TO 26:03 (RUNNING 00:00:12.200)

20 Q. Sir, could you tell us what was in
21 that report?
22 MR. JAKES: I'm going to object on
00026:01 the grounds of attorney-client privilege. The
02 contents of the communication are privileged.
03 Instruct you not to answer.

4. PAGE 28:03 TO 28:14 (RUNNING 00:00:25.500)

03 Q. And you worked for the law firm of
04 Fulwider, Patton, Lee & Utecht from 1984 to 1991,
05 correct?
06 A. That's correct.
07 Q. Sir, do you recall what month in 1991
08 you left the Fulwider firm?
09 A. I think it was June or July. I'm not
10 sure which.
11 Q. And, sir, part of the work that you
12 did at the Fulwider firm was preparing and
13 prosecuting patent applications, correct?
14 A. That's correct.

5. PAGE 28:15 TO 28:19 (RUNNING 00:00:09.500)

15 Q. And, sir, part of the work that you

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04 that report?
05 A. I don't recall getting the
06 instructions for it, but I assume that it would be
07 from Mr. Barclay.

20. PAGE 54:08 TO 54:12 (RUNNING 00:00:20.600)

08 Q. And, sir, did you -- do you know why
09 you prepared the report?
10 A. It seemed to me that -- that Advanced
11 Cardiovascular System was talking to people that
12 were involved with the E.S.S. application.

21. PAGE 54:13 TO 54:20 (RUNNING 00:00:15.100)

13 Q. And do you have any recollection of
14 what those discussions were about as far as you
15 were concerned?
16 A. As far as I was concerned, I was not
17 involved in those discussions.
18 Q. Do you remember any details about the
19 purpose and scope of those discussions?
20 A. No, I don't.

22. PAGE 54:21 TO 55:11 (RUNNING 00:00:24.500)

21 Q. Sir, did your report cover the scope
22 of the claims of the E.S.S. application?
00055:01 MR. JAKES: I'm going to object on
02 the grounds of attorney-client privilege. The
03 contents of the report are privileged, and
04 Mr. Lynch -- I don't think he can answer that
05 question.
06 BY MR. O'NEILL:
07 Q. Sir, did your report cover the scope
08 of the disclosure of the E.S.S. application?
09 MR. JAKES: I'm going to make the
10 same objection. Instruct the witness not to
11 answer.

23. PAGE 57:10 TO 57:13 (RUNNING 00:00:09.300)

10 When -- did you review the E.S.S.
11 application before you were involved in preparing
12 and reviewing the Lau application?
13 A. I believe so, yes.

24. PAGE 63:19 TO 64:04 (RUNNING 00:00:15.600)

19 Q. The Lau application, was that the
20 first patent application that you prepared for
21 ACS?
22 A. Oh, no.
00064:01 Q. How many had you prepared before
02 that?
03 A. Oh, I don't know. 15 maybe. 30. I
04 don't know the number.

25. PAGE 83:03 TO 83:05 (RUNNING 00:00:12.800)

03 Q. This is a document that starts with a
04 cover letter dated March 9, 1990, and it bears
05 Bates labels ACS 426579 through to -597.

26. PAGE 84:22 TO 85:03 (RUNNING 00:00:12.700)

22 Q. Sir, do you recall receiving these
00085:01 documents that we've marked as Exhibit 7, around
02 the March 9, 1990, time period?
03 A. I have no recollection of that.

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10 have other reference materials which discuss the
11 Gianturco stent and its eventual abandonment. I
12 can provide these to you if you wish."

35. PAGE 90:13 TO 90:15 (RUNNING 00:00:06.200)

13 Do you recall ever following up with
14 Mr. Eakin to discuss the Gianturco patent?
15 A. No, I don't.

36. PAGE 90:16 TO 90:22 (RUNNING 00:00:18.600)

16 Q. Do you have any recollection, as you
17 sit here today, of the Gianturco patent or the
18 Gianturco stent?
19 A. I have some recollection of the
20 Gianturco stent, but I'm not sure what time frame
21 that relates to or whether it involves this
22 particular activity.

37. PAGE 91:01 TO 91:13 (RUNNING 00:00:31.624)

00091:01 Q. And what is your recollection of the
02 Gianturco stent?
03 A. I know that it exists.
04 Q. Do you recall anything about it?
05 A. Well, I know, based upon reading the
06 report, I apparently --
07 MR. JAKES: Mr. Lynch, I'm going
08 to -- before you go down that road, I don't want
09 you to reveal the communications in your report.
10 So if you have a recollection of what was in
11 Gianturco, I think that's perfectly fair game; but
12 otherwise, let's stay away from what was in your
13 report.

38. PAGE 100:22 TO 101:03 (RUNNING 00:00:08.700)

22 Q. Sure. Have you ever had an
00101:01 understanding that a stent that is less than four
02 millimeters long wouldn't be considered in the
03 industry as a stent?

39. PAGE 101:06 TO 101:07 (RUNNING 00:00:04.500)

06 THE WITNESS: I have no knowledge one
07 way or the other on that.

40. PAGE 102:12 TO 102:15 (RUNNING 00:00:18.127)

12 MR. O'NEILL: Mark as Exhibit 9 a
13 one-page document titled "Billing Preview for
14 Edward J. Lynch, Richard A. Bardin." It bears
15 Bates label ACS 53-3022.

41. PAGE 103:03 TO 103:06 (RUNNING 00:00:06.900)

03 Q. Do you recall review- -- do you
04 recall seeing this document outside of your review
05 with counsel?
06 A. I don't have a recollection of it.

42. PAGE 103:11 TO 103:13 (RUNNING 00:00:03.200)

11 Q. Can you tell us what this document
12 is?
13 A. It's a prebill.

43. PAGE 103:20 TO 104:07 (RUNNING 00:00:25.800)

20 Q. And, sir, am I correct in saying that

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109. PAGE 163:07 TO 163:10 (RUNNING 00:00:11.300)

07 Q. Sir, do you agree that your
08 involvement in the Lau application triggered a
09 duty of disclosure on your part?
10 A. Sure.

110. PAGE 168:11 TO 168:21 (RUNNING 00:00:23.900)

11 Q. Do you recall having any discussions
12 with anyone at ACS, not ACS' attorneys, regarding
13 the differences between the stent that was
14 disclosed in the E.S.S. application and the stent
15 that was disclosed in the Gianturco stent --
16 Gianturco patent?
17 A. Prior to my discussions with counsel,
18 no.
19 Q. No, you didn't, or no, you don't
20 remember?
21 A. I don't remember.

111. PAGE 168:22 TO 169:05 (RUNNING 00:00:11.000)

22 Q. Was the Gianturco stent something
00169:01 that you had discussed in your report to
02 Mr. Barclay?
03 MR. JAKES: Objection. That's
04 attorney-client privilege, and I'll instruct you
05 not to answer that one.

112. PAGE 169:18 TO 170:15 (RUNNING 00:00:45.800)

18 Q. Sir, at the time that you were
19 working on the Lau application, did you believe
20 that the stent that was disclosed in the E.S.S.
21 application was material?
22 A. I don't recall ever making that
00170:01 conclusion.
02 Q. Do you recall ever thinking about
03 that?
04 A. No.
05 Q. At the time that you were working on
06 the Lau application, did you remember the work
07 that you were doing that you had done on the
08 E.S.S. application?
09 A. No.
10 Q. You don't remember, or are you saying
11 you definitively didn't remember?
12 A. I don't recall the E.S.S. application
13 at all. And I don't recall whether I did not
14 recall it at the time I was preparing the -- or
15 reviewing the drafts of the Lau application.

113. PAGE 170:21 TO 171:07 (RUNNING 00:00:18.100)

21 Q. Is there a reason why you didn't
22 disclose the E.S.S. application to the Patent
00171:01 Office in connection with your work on the Lau
02 application?
03 A. Yes.
04 Q. Why is that?
05 A. I had -- the file had been
06 transferred to another firm. I no longer had any
07 responsibility for it.

114. PAGE 171:16 TO 172:14 (RUNNING 00:00:26.000)

16 Q. Sir, would you agree with me that the
17 E.S.S. application was material to the Lau

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18 application?
19 THE WITNESS: I don't --
20 MR. JAKES: Before you answer, I just
21 want to make sure. Are you asking about what he
22 remembers, if he remembers thinking about that? I
00172:01 think you've already answered that question.
02 MR. O'NEILL: I have already asked
03 that question.
04 MR. JAKES: If you're asking him for
05 his opinion today, he's not going to give those
06 opinions.
07 MR. O'NEILL: I'm not asking for his
08 opinion. I'm just asking for what he thinks.
09 MR. JAKES: That's the same thing.
10 THE WITNESS: What time frame?
11 BY MR. O'NEILL:
12 Q. Right now.
13 MR. JAKES: I object to that. You
14 don't have to answer that, Mr. Lynch.

115. PAGE 183:04 TO 183:14 (RUNNING 00:00:26.500)

04 Q. Sir, are you aware that ACS filed a
05 number of continuations, continuations in part,
06 and divisional applications that came off of the
07 Lau application that you worked on? Were you
08 aware of that, sir?
09 A. Yes, I am aware of that.
10 Q. Sir, did you participate in any way
11 at all with respect to the preparation or
12 prosecution of any of those applications?
13 A. I don't believe I did, but I can't
14 guarantee that.

116. PAGE 187:17 TO 188:03 (RUNNING 00:00:19.701)

17 Q. Sir, after you left the Crosby firm
18 and you went to Heller Ehrman, did you continue to
19 do work for ACS?
20 A. Yes, I did.
21 Q. And what percentage of your practice
22 was devoted to doing work for ACS while you were
00188:01 at Heller Ehrman?
02 A. It remained substantial, but a less
03 percentage than what it was at Crosby.

117. PAGE 196:14 TO 196:16 (RUNNING 00:00:11.077)

14 MR. O'NEILL: Two more. Mark as
15 Exhibit 23 the file history for United States
16 Patent 5,728,158.

118. PAGE 196:20 TO 196:22 (RUNNING 00:00:07.307)

20 Q. And, again, sir, if you can please
21 take a look at this document. Take your time.
22 Let us know whether you've ever seen this before.

119. PAGE 197:01 TO 197:11 (RUNNING 00:00:22.100)

00197:01 A. I don't recall having any contact
02 with the application.
03 Q. Sir, do you recall playing any role
04 in the preparation or prosecution of the
05 application that's at issue in this file history?
06 A. No, I don't.
07 Q. Do you recall having any discussions
08 with anyone regarding what prior art should be
09 disclosed to the Patent Office in connection with

CERTIFICATE OF SERVICE

I hereby certify that on June 7, 2005, I electronically filed the foregoing with the Clerk of the Court using CM/ECF which will send notification of such filing to Frederick L. Cottrell, III.

I further certify that on June 7, 2005, I caused to be served copies of the foregoing document on the following in the manner indicated:

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